

Remarks

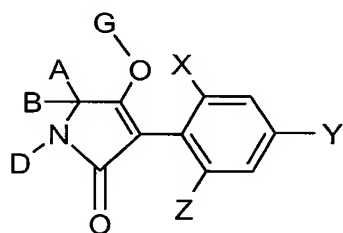
Reconsideration of this Application is respectfully requested.

Applicants wish to thank the Office for withdrawal of the Objections to the Specification and claim rejection under 35 U.S.C. § 112, second paragraph. Upon entry of the foregoing amendment, claims 3-6, 8, 9, and 11-15 are pending in the application, with claim 3 being the independent claim. Claims 3-6 have been amended to conform to the Office's election of subject matter. Claims 17-19 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

I. Description of the Invention

The present invention relates to novel compounds of formula (I),



(I)

to a plurality of processes and intermediates for their preparation and to their use as pesticides and/or herbicides. The invention also relates to novel selective herbicidal active compound combinations compounds of formula (I) and at least one crop plant compatibility improving compound for use in the selective control of weeds in crops of useful plants.

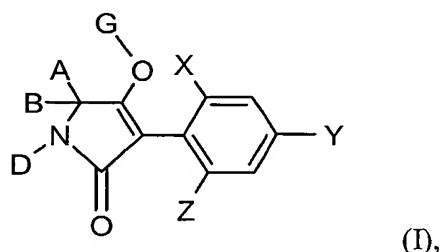
II. Objection to the Claims

The Office has objected to the claims because they allegedly contain non-elected subject matter. Applicants have amended the claims to define subject matter described in the non-final Office Action mailed on March 3, 2009. In view of this amendment, Applicants respectfully request that this objection be withdrawn.

III. Rejections under 35 U.S.C. § 103

The rejection of claims 3-5 and 8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,469,196 to Fischer *et al.* ("the '196 patent") is respectfully traversed.

Claim 3 is directed to a compound of formula I



wherein X is halogen, Y is alkyl, Z is C₂-C₆ alkyl, G is hydrogen, A is hydrogen or C₂-C₈ alkyl, B is hydrogen or C₁-C₂ alkyl and D is hydrogen or optionally substituted C₃-C₆ cycloalkyl.

The Office states that the instantly claimed compounds would have been allegedly obvious over the '196 compounds because the '196 patent teaches herbicides and/or pesticides sharing the same core structure as the instantly claimed compounds. The Office further states that the only difference between the '196 compound and the instant application is the presence of an ethyl group instead of a methyl group at the Z position. Office Action, p. 3. Applicants respectfully disagree.

Applicants claims as amended are directed to compounds wherein the Z group is an ethyl or propyl substituent and A, B and D groups have a substitution pattern as defined above. The Office has provided no reason why a person of ordinary skill in the art would select a specific compound from the '196 patent with the X, Y, Z, A, B and D substitution pattern of the instantly claimed compounds as a starting point from among the thousands of compounds recited by the '196 patent. The rationale the Office has provided is not sufficient to modify the selected lead compound in such a way as to arrive at the current invention. Accordingly, claims 3-5 and 8 are not *prima facie* obvious in light of the '196 patent and the rejection should be withdrawn.

Even assuming that a *prima facie* case of obviousness has been established, which it has not, the unexpected herbicidal action exhibited by the claimed compounds is sufficient to overcome any *prima facie* case of obviousness. Applicants resubmit herewith a Declaration under 37 C.F.R. § 1.132 ("Declaration") which recites the unexpected superiority of compounds of the claimed invention over the '196 patent. The Office states that the 132 declaration filed on 06/01/2009 is not sufficient to overcome the rejection for the following reasons: (1) the Declaration did not declare who created the testing data, and how the data related to the instant application; and (2) the Declaration was not filed by Dr. Heinz Kehne because it used "he" not "I." Office Action, p. 3.

The Declaration resubmitted herewith is filed by Dr. Heinz Kehne in the first person. The Declaration also clearly states that the tests have been carried out under his supervision and direction. The compounds labeled as "BCS03-3067" are compounds encompassed by the instant claims and therefore relate to the instant application.

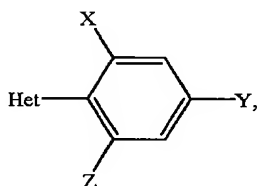
The Office also states that the compounds tested in the Declaration are compounds wherein X is -Br, not -Cl, as cited in the '196 patent, and no unexpected results have been demonstrated over the prior art compounds. Applicants respectfully disagree. The '196 patent discloses compounds wherein X is -Br in Table 4. (The '196 patent, col. 44-45.) The results in the Declaration illustrate that a compound of the present invention with an ethyl group at the Z position were unexpectedly superior to the compounds from the '196 patent even at lower levels of application. Declaration, pages 2-8. For example, compound 1-b-2 of the present invention exhibits an efficacy of 100% in the destruction of Setvi and ECHCG weeds at an application rate of 80 g/ha when compared to a 20% and 70% efficacy of a compound from the '196 patent applied at a rate of 250 g/ha. *Id.*, at page 2. A second illustrative compound, 1-b-18, also demonstrates an efficacy of 100%, 100% and 90% in the destruction of Setvi, Avefa and Alomy weeds respectively, at an application rate of 80 g/ha. In comparison, a compound from the '196 patent has an efficacy of 90%, 80% and 50%, in each of the weeds respectively, when applied at a rate of 250 g/ha. Declaration, at page 6.

The data, therefore, show that when exemplary compounds of the present invention are compared against an exemplary compound of the '196 patent in the same experiment, the compound of the present invention showed superior weed killing activity. Applicants respectfully request that the rejection of claims 3-5 and 8 be withdrawn.

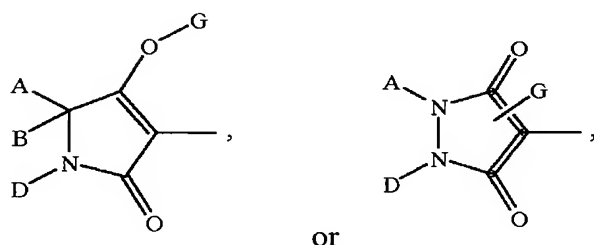
IV. Obviousness Type Double Patenting

The rejection of claims 3-5 and 8 as allegedly being unpatentable on the ground of obviousness-type double patenting over claims 1-4, 6 and 8 of U.S. Patent No. 5,994,274 ("the '274 patent") is respectfully traversed.

The claims of the '274 patent are directed to compounds of formula (I)



wherein X is alkyl, Y can be halogen or alkyl, Z can be halogen or alkyl, Het is

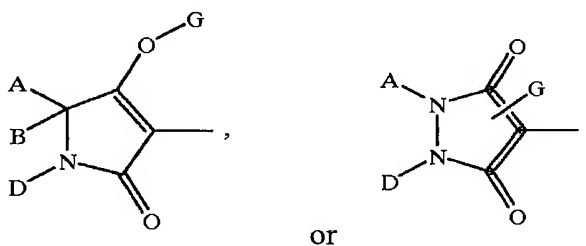


and A and B are separately substituted, or A and B together with the carbon atom to which they are bonded, represent a saturated or unsaturated, optionally substituted carbocycle or heterocycle. The claims of the present invention, in contrast recite a much smaller genus of compounds wherein X is halogen, Y is alkyl, Z is C₂-C₆ alkyl, G is hydrogen, A is hydrogen or C₂-C₈ alkyl, B is hydrogen or C₁-C₂ alkyl and D is hydrogen or optionally substituted C₃-C₆ cycloalkyl.

The Office states that the scope of instant claims 3-5 and 8 and claims 1-4, 6 and 8 of the '274 patent have an overlapping core structure, and points to a specific compound (CAS RN 186746-85-0) disclosed in the '274 patent as a homolog that reads on the instant claims. Office Action, pgs. 3-4. Applicants respectfully disagree with the Atty. Dkt. No. 2400.0300000/JMC/CMB/AKN

Office's position that the claims of the '274 patent render obvious the claims of the instant application. According to the M.P.E.P. and the cases cited therein, in order to establish a *prima facie* case of obviousness of a species any teachings of a "typical," "preferred," or "optimum" species or subgenus within the disclosed genus should be considered. M.P.E.P. § 2144.08.II.A.4(c). The M.P.E.P. further states that "[i]n making an obviousness determination, Office personnel should consider the number of variables which must be selected or modified, and the nature and significance of the differences between the prior art and the claimed invention." M.P.E.P. § 2144.08.II.A.4(c).

Claim 1 of the '274 patent recites a very broad genus of compounds. Claims 2, 3 and 4 each recite a sub-genus that is progressively narrower than the genus recited in claim 1. However, even the narrowest sub-genus recited in claim 4 of the '274 patent is directed to a very large group of compounds wherein X represents methyl, ethyl, n-propyl or iso-propyl, Y represents fluorine, chlorine, bromine, methyl, ethyl, n-propyl or iso-propyl, Z represents fluorine, chlorine, bromine, methyl, ethyl, n-propyl or iso-propyl, Het represents



and A, B, D and G represent a large number of possible substituents. Therefore, even the narrowest dependent claims of the '274 patent are much broader than the present claims. Applicants therefore submit that the claims of the '274 patent do not point a person of ordinary skill in the art to a "typical," "preferred," or "optimum" species or

subgenus that would lead one of skill in the art to the subject matter of the present claims. Furthermore, even the narrowest claims of the '274 patent contain a large number of variables that must be appropriately selected in order to arrive at the claimed compounds of the present invention. Applicants respectfully submit that the Office is employing impermissible hindsight in picking the appropriate variables from among the numerous choices in the compounds claimed in the '274 patent in order to arrive at the compounds of the present invention. Furthermore, in pointing to a specific compound disclosed in the specification of the '274 patent, the Office is impermissibly using the specification as prior art. M.P.E.P. § 804.II.B.1.

Even assuming that the claims of the present invention are obvious in view of the claims of the '274 patent, which they are not, the unexpected herbicidal action exhibited by the claimed compounds is sufficient to overcome any *prima facie* case of obviousness. Compounds labeled "BCS03-3067" are compounds according to the present invention and are compared to compounds from WO97/02243, a parent of the '274 patent.

The results in the Declaration illustrate that a compound of the present invention with an ethyl group at the Z position were unexpectedly superior to the compounds from the '274 patent even at lower levels of application. For example, compound I-a-2-7 of the present invention exhibits an efficacy of 80% and 40% in the destruction of Alomy and Avefa weeds, respectively, at an application rate of 80 g/ha. In comparison, a compound from the '274 patent has an efficacy of 80% and 20%, in each of the weeds respectively, when applied at a much higher rate of 250 g/ha. *Id.*, at page 8.

The data, therefore, show that when exemplary compounds of the present invention are compared against an exemplary compound of the '274 patent in the same experiment, the compound of the present invention showed superior weed killing activity. *Id.* Applicants respectfully request that the rejection of claims 3-5 and 8 be withdrawn.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Cynthia M. Bouchez
Attorney for Applicants
Registration No. 47,438

Date: December 23, 2009

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600
1059960_1.DOC